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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/634,101

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Junichi Kurihara

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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

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10/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/634,101

Applicant(s)

KURIHARA, JUNICHI

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This case has been reassigned to a new examiner.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. MPEP 2164.01 describes the test of enablement. MPEP 2164.01(a) details the factors to be considered when determining if the disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue". These factors include, but are not limited to:

- (a) The breadth of the claims;
- (b) The nature of the invention;
- (c) The state of the prior art;
- (d) The level of one of ordinary skill;
- (e) The level of predictability in the art;
- (f) The amount of direction provided by the inventor;
- (g) The existence of working examples; and
- (h) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

The *Wands* factors are applied to the disclosure and claims below.

- (a) The breadth of the claims: Applicant's invention is directed toward a content delivery system, apparatus, and method. The content is delivered by streaming said content over the Internet.

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- (b) The nature of the invention: Applicant's invention is a content delivery system, operating over the Internet.
- (c) The state of the prior art: Transferring files between computers is well known in the prior art. Streaming files between the computers is well known in the prior art.
- (d) The level of one of ordinary skill: The level of one of ordinary skill can be presumed to possess a Bachelor's degree in electrical or computer engineering, and 3-5 years of industry experience. Alternately, the level of one of ordinary skill can be presumed to be the skill of a person who would have invented Applicant's invention.
- (e) The level of predictability in the art: Applicant's invention is in the networking field, which is a stable and relatively predictable art.
- (f) The amount of direction provided by the inventor: Applicant's invention as claimed cannot be implemented based on Applicant's disclosure.

Applicant claims *content delivering means for providing said users with of [sic] said contents stored in said user areas solely as streaming content wherein the content files are not downloadable by the corresponding user*. All delivered content must be "downloaded" to the user in some manner. One of ordinary skill is unaware of any process that allows a user to access any data over the web without "downloading" it in some manner.

Microsoft's Computer Dictionary, Fifth edition defines "download" as "In communications, to transfer a copy of a file from a remote computer to the requesting computer by means of a modem or network" or "To send a block of data, such as a PostScript file, to a dependent device, such as a PostScript printer." Both definitions are equally applicable as showing that a user must be able to download content if the user is provided with content. When a user receives content by streaming, that content is "transferred" as "a copy of a file from a remote computer to the requesting computer by means of a modem or network." If one were to consider that only a portion of the content was streamed, that portion would be "sending a block of data... to a dependent device" where the dependent device was the device receiving the content. The device receiving the content is "dependent" upon the device transmitting the content.

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(g) The existence of working examples: Applicant provided no working examples to the Office.

(h) The quantity of experimentation needed to make or use the invention based on the content of the disclosure: Communications and networking theory dictates that in order to view a file in any form, the content must be passed to the computer. The content must exist on the computer in some form in a memory, buffer, register, or storage device in order to be viewed on the computer. In order to get content that does not exist on a computer to be displayed, it must be transferred to that computer in some form. The transfer of data is called "downloading" as defined above. Applicant's invention provides content while stating the content is "not downloadable by the corresponding user." Because communications and networking theory precludes any possible way of displaying data without some form of transference or downloading of data when it is not present on a machine, one of ordinary skill would suffer the burden of undue experimentation to create an invention that cannot exist in the art as claimed.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 4-6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. In regard to claims 1, 6, 8, the limitation *file managing means for managing the content files stored in said content file storing means and the contents stored in the user areas of said user-oriented content storing means wherein the file managing means copies content files selected by the user from the content file storing means to the user-oriented content storing means* is indefinite. One of ordinary skill cannot reasonably determine which user selects the content to be copied. The limitation can be read as the providing user selects the content, or alternately as the receiving user selects the content.

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8. In regard to claims 1, 8, the limitation *content delivering means for providing said users with of [sic] said contents stored in said user areas solely as streaming content wherein the content files are not downloadable by the corresponding user* is indefinite. Two possible readings of the limitation exist. The first reading allows for the streaming of the stored contents in the said user areas. An alternate reading allows for the storage of contents *solely as streaming content*, where the content is either stored as a stream of data, streamed from another source and forwarded as an additional stream, or stored with a parameter limiting delivery to streaming content.

9. In regard to claims 1, 6, 8, the limitation *wherein each of said users is charged a usage fee proportional to the user area size allocated to the corresponding user in said user-oriented content storing means* is indefinite. It is unclear if the user that is charged the user fee is the transmitting user or the receiving user. It is unclear if the user area size is allocated to the transmitting user or the receiving user. One of ordinary skill cannot reasonably determine what Applicant's invention is from the wording of this limitation. For purposes of compact prosecution, the user fee is treated as being charged to the transmitting user or the source of the initial content.

10. Claims 4 and 5 recite the limitation "said user area of a given user" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Rangan et al. (US 6,154,771).

13. In regard to claim 1, Rangan disclosed:

content file storing means for storing files of said contents; column 11, lines 53-63

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user-oriented content storing means in which a user area of a predetermined size is allocated to each of said users for the storage of a content owned by a corresponding one of the users; column 11, lines 55-63

file managing means for managing the content files stored in said content file storing means and the contents stored in the user areas of said user-oriented content storing means, wherein the file managing means copies content files selected by the user from the content file storing means to the user-oriented content storing means; and column 23, lines 57-60

content delivering means for providing users with of [sic] said contents stored in said user areas solely as streaming content wherein the content files are not downloadable by the corresponding user, column 23, line 64 – column 24, line 5

wherein each of said users is charged a usage fee proportional to the user area size allocated to the corresponding user in said user-oriented content storing means. The transmission of advertisements by inherency teaches a user (advertiser) is charged a usage fee for transmission to the corresponding user. Column 21, line 35

14. In regard to claim 2, Rangan disclosed:

said content files are moving picture files. Column 21, lines 22-26

15. In regard to claim 3, Rangan disclosed:

said content management unit further comprises picture processing means for carrying out picture processing to superpose personal information about a given user on a streaming screen of the content being delivered to the corresponding user. Column 21, lines 58-67. The transmission of inserted information such as interactive commercials, dynamic hyperlinks, security information, text captions and other control information are "personal information about a given user".

16. In regard to claim 4, Rangan disclosed:

a copied content file is stored into said user area of a given user as the content owned by the corresponding user. Column 21, lines 22-26

17. In regard to claim 5, Rangan disclosed:

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a link file linked to a content file is stored into said user area of a given user in lieu of the content owned by the corresponding user. Column 22, lines 30-40

18. Claim 6 is substantially the same as claim 1.
19. Claim 7 is substantially the same as claims 2-3.
20. Claim 8 is substantially the same as claims 1 and 3.
21. In regard to claim 9, Rangan disclosed:

the personal information includes a user identification. Column 21, lines 58-67. The transmission of inserted information such as interactive commercials, dynamic hyperlinks, security information, text captions and other control information are "a user identification".

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rangan.
24. In regard to claim 10, Rangan disclosed inserting customized text captions over video being streamed to users. Rangan further stated security information and other control information could be inserted in video. See Rangan, column 21, lines 58-61. Rangan failed to disclose the explicit insertion of a user's credit card number, telephone number, address, and name into a video being streamed across the World Wide Web to other users. It would have been obvious to one of ordinary skill in the art that any information could be inserted into the video of Rangan because Rangan allowed for customizable text captions. It would have been further obvious to one of ordinary skill in the art to insert a credit card number, telephone number, address and name into the video streamed by Rangan to allow for identification of the source of the video, and to further allow for generous benefactors to facilitate purchases and personal credit alterations by other users over the Internet by using the generous benefactor's credit information.

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Response to Arguments

25. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.
26. The examiner requests clarification of the invention. It is not apparent if Applicant intended to claim the invention in its current form. The apparent invention as currently claimed is a video streaming apparatus where a user uploads a video to the video server, the user pays for the video server to distribute the video, and the video is streamed to other computers displaying the originating user's credit information for all viewers to see and access.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- | | |
|-----------------|-----------------|
| Auerbach | US 6,832,253 B1 |
| Wong et al. | US 6,968,364 B1 |
| Reynolds et al. | US 7,020,888 B2 |
28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jason Cardone
Supervisory Patent Examiner
Art Unit 2145

JRS